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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,598	07/20/2006	Tadashi Maeda	2006_1151A	1659
513 7590 10/06/2011 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER MEHTA, MEGHA S				
ART UNIT 1783		PAPER NUMBER		
NOTIFICATION DATE 10/06/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/586,598

Applicant(s)

MAEDA ET AL.

Examiner

MEGHA MEHTA

Art Unit

1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 16-39 is/are pending in the application.
- 5a) Of the above claim(s) 16-26 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 27-39 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SD-03)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 1, 2011, has been entered.
2. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 27-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,189,771 Maeda et al in view of US 2002/0185309 Imamura et al and further in view of US 6,680,128 Mei in view of US 5,837,119 Kang et al.

Regarding claim 27, Maeda teaches a soldering process with which a first electrode having a solder portion **9** thereon is soldered to a second electrode **1** (column 1, lines 13-16), wherein the process comprises, a first step of supplying a flux (in **5**) to at least one of the solder portion and the second electrode (column 4, lines 1-8), a second step of aligning the first electrode with the second electrode so as to locate the flux between the solder portion and the second electrode (column 5, lines 26-28), a third step of heating so as to melt the solder portion, so that a molten solder material from the solder portion comes in contact with the second electrode (column 5, lines 32-35). Maeda does not explicitly teach the fourth step of solidifying the molten solder material after the third step. However, this would have been obvious to one of ordinary skill in the art at the time of the invention because the purpose of solder is to adhere two pieces together and a liquid solder would not suffice.

Maeda additionally does not teach the flux composition.

Imamura teaches a method of mounting an electronic component with solder bumps to a substrate by using a flux that comprises a liquid base material **118** comprising a resin component

which is dissolved in a solvent (paragraph 0066), an active component which removes an oxide (paragraph 0066), and a metal powder **116** made of a metal of which melting point is higher than that of a solder material which forms the solder portion **112** (paragraph 0064), where the flux contains the metal powder in an amount in the range between 1% and 9% by volume based on a volume of the flux (paragraph [0078]). It would have been obvious to one of ordinary skill in the art to include the flux of Imamura in the method of Maeda because one may vary the flux composition based on the desired final result and the effect of the flux on the product being made.

Neither Maeda nor Imamura teaches that the metal powder is in the form of scales. Kang teaches a method of creating a highly conductive paste for use in electronic applications. Kang teaches that the powder in the conductive paste is preferably plate of flake-shaped (column 5, lines 35-40). Kang does not teach that this powder is a constituent of the flux; it is in the solder. However, as known in the art and taught by Mei, it is common to include a solder material in the flux material such that the application process is simplified into a single step. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the flake-shaped powders of Kang in the solder paste of Mei because this produces a better electrical connection with a minimum of filler material (column 5, lines 35-40). Mei also teaches that the solder may be mixed into the flux, forming a solder paste (column 5, lines 13-15). In this way, the flake-shaped metal particles are in the solder, which is in the flux; the metal particles are in the flux.

Regarding claim 28, Maeda teaches the solder portion is a bump which is formed on the first electrode (column 5, lines 15-22).

Regarding claim 29, Maeda teaches that the first electrode is an external connection electrode of an electronic part (column 5, lines 15-22).

Regarding claim 30, Maeda teaches that the second electrode is an electrode of a circuit formed on a substrate.

Regarding claim 31, Maeda teaches supplying the flux carried out in a flux application step wherein a film of the flux is formed, and then a lower end portion of the solder portion is made in contact with the film (column 4, line 58 – column 5, line 1 and figure 4A).

Regarding claim 32, Maeda teaches the soldering process but does not explicitly teach a cooling step. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to solidify the molten solder material through a cooling step wherein the molten solder material is cooled because cooling and thus solidifying the solder is the only way for the solder to hold two pieces together.

Regarding claim 33, Maeda in view of Imamura teach the majority of the limitations with respect to claim 27 above. Neither Maeda nor Imamura teaches a metal powder in the form of scales of which constituting elements are comprised of cores and coatings around the cores, wherein the coatings are made of a metal of which melting point is higher than that of a solder material which forms the solder portion.

Mei teaches a method of making a solder paste where the solder paste may be used in any application, including the bonding of electronic components. Mei teaches that the solder composition is preferably a metal alloy of tin coated with silver (column 2, lines 19-22), where the tin is the core and the silver is the coating around the core. Mei further teaches that the coatings are made of a metal which has a melting point higher than that of a solder material

which forms the solder portion (column 5, lines 12-13). Mei does not teach that these metal particles are particles in the flux. Instead, Mei teaches that the particles are in the solder. However, Mei also teaches that the solder may be mixed into the flux, forming a solder paste (column 5, lines 13-15). In this way, the metal particles are in the solder, which is in the flux; the metal particles are in the flux.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the cores and coatings around the cores of Mei in the method of Maeda and Imamura because this improves the wettability characteristics and shelf life of the solder paste (column 2, lines 14-18).

Mei does not teach that the particles are scale-shaped. Kang teaches a method of creating a highly conductive paste for use in electronic applications. Kang teaches that the powder is preferably plate of flake-shaped (column 5, lines 35-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the flake-shaped powders of Kang in the solder paste of Mei because this produces a better electrical connection with a minimum of filler material (column 5, lines 35-40).

Regarding claims 34, Maeda teaches the solder portion is a bump which is formed on the first electrode (column 5, lines 15-22).

Regarding claim 35, Maeda teaches that the first electrode is an external connection electrode of an electronic part (column 5, lines 15-22).

Regarding claim 36, Maeda teaches that the second electrode is an electrode of a circuit formed on a substrate.

Regarding claim 37, Maeda teaches supplying the flux carried out in a flux application step wherein a film of the flux is formed, and then a lower end portion of the solder portion is made in contact with the film (column 4, line 58 – column 5, line 1 and figure 4A).

Regarding claim 38, Maeda teaches the soldering process but does not explicitly teach a cooling step. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to solidify the molten solder material through a cooling step wherein the molten solder material is cooled because cooling and thus solidifying the solder is the only way for the solder to hold two pieces together.

Regarding claim 39, Mei teaches that the solder composition is preferably a metal alloy of tin coated with silver (column 2, lines 19-22), where the tin is the core and the silver is the coating around the core. “[M]ade of” is broadly interpreted as “comprising”.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 27, 33 and 39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-6 of copending Application No. 10/585,729. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the two claims are as follows:

- a. Claim 27 does not require the limitation of a metal particle with a core and a coating around the core. However, as the claim recites “comprises”, this limitation is not excluded from being present. As claim 33 includes the limitations of claim 27 and presents additional limitations, the remainder of the differences will be addressed with respect to claim 33 with the understanding that they apply to claim 27 as well.
- b. Claim 33 recites “a first step of supplying a flux”. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the flux

of the instant invention in the method of 10/585,729 because fluxes are well known in the art for their usefulness in cleaning surfaces prior to bonding such that the bond to be formed is superior in its integrity to a bond formed on a surface that has not been cleaned.

c. Claim 33 recites “wherein the coatings are made of a metal which has a melting point higher than that of a solder material which forms the solder portion”. However, as evidenced by claim 6 in 10/585,729 compared to claim 39 of the instant application, the silver coating/tin core structure of the instant application is the same silver coating/tin core intended in 10/585,729. Therefore, this inherent property of silver having a higher melting temperature than tin would necessarily be present in 10/585,729. Furthermore, claim 4 of 10/585,729 also recites “comprising” such that this limitation is not excluded from the claim.

d. Claim 4 recites “wherein the solder portion easily wets and spreads along the surface metal when the solder portion is fluidized”. However, this limitation would be obvious to one of ordinary skill in the art at the time the invention was made because solder is used to join two objects. Being easily wettable and spreading along the surface are requirements in order for the solder to function as it should. Solder that is not easily wettable often creates defects in the final product due to insufficient bonding.

e. Claim 4 recites “1-20 vol%” regarding the amount of metal powder in the soldering paste. However, the instant application recites 1-9 vol%, which is encompassed by 1-20 vol%.

f. Claim 4 recites, “in the step (c), the surface of the core metal is exposed at a portion of the metal powder which is not in contact with the molten solder, while the

surface metal is taken into the core metal by dissolution.” However, as the soldering method of the instant invention is not structurally indistinguishable from that of 10/585,729, it would be reasonable to expect that the soldering material of the instant invention would also exhibit an exposed core not in contact with the molten solder while the surface metal is taken into the core metal by dissolution. Moreover, the instant invention recites “comprises” such that this limitation is not excluded from being present.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 27, 33 and 39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 7,632,710. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the two claims are as follows:

- a. Claim 27 does not require the limitation of a metal particle with a core and a coating around the core. However, as the claim recites “comprises”, this limitation is not excluded from being present. As claim 33 includes the limitations of claim 27 and presents additional limitations, the remainder of the differences will be addressed with respect to claim 33 with the understanding that they apply to claim 27 as well.
- b. Claim 33 recites “a first step of supplying a flux”. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the flux of the instant invention in the method of 7,632,710 because fluxes are well known in the art for their usefulness in cleaning surfaces prior to bonding such that the bond to be formed is superior in its integrity to a bond formed on a surface that has not been cleaned.

c. Claim 33 recites “wherein the coatings are made of a metal which has a melting point higher than that of a solder material which forms the solder portion” while claim 1 recites “including a core segment of the metal molten at a higher temperature than the liquid phase temperature of solder”. However, as evidenced by claim 2 in 7,632,710 compared to claim 39 of the instant application, the silver coating/tin core structure of the instant application is the same silver coating/tin core intended in 10/585,729. Therefore, this inherent property of silver having a higher melting temperature than tin would necessarily be present in 7,632,710. It is understood that the recitation of claim 1 is incorrect.

d. Claim 1 recites “a surface segment of the metal with good wettability for said solder molten to be solid-solved in said core segment molten”. However, this limitation would be obvious to one of ordinary skill in the art at the time the invention was made because solder is used to join two objects. Being easily wettable and spreading along the surface are requirements in order for the solder to function as it should. Solder that is not easily wettable often creates defects in the final product due to insufficient bonding. Furthermore, as the soldering method of the instant invention is not structurally indistinguishable from that of 7,632,710, it would be reasonable to expect that the soldering material of the instant invention would also exhibit an exposed core not in contact with the molten solder while the surface metal is taken into the core metal by dissolution. Moreover, the instant invention recites “comprises” such that this limitation is not excluded from being present.

Response to Arguments

3. Applicant's arguments filed September 1, 2011, have been fully considered but they are not persuasive.

It is unclear to the Examiner why the definition of "particle" is at issue. "Particle" is not recited in the claims and is clearly a generic term for all geometries of atoms and molecules. However, to respond to the Applicant's concerns, the following is provided.

Applicant argues that there are no particles left in the solder mass after solidification. However, this is incorrect because the solder must re-solidify. It does not stay in a liquid state forever. The solder is melted and then cooled to become solid again after the reflow process. Therefore, in the resolidification process, the metal particles nucleate and grow until all of the solder has been solidified. Therefore, after the solidification process, the particles in the solder have returned. The claim does not require that the particles in the solder mass after solidification are the same particles that were in the mixture before melting of the solder.

Applicant argues that the solidified mass does not contain metal particles that correspond to scales. However, the claim does not require scales to be present in the solidified solder, only before melting.

Applicant argues that the Examiner equates "particles" to atoms. However, please note that this was used as an example to illustrate that Applicant has not defined particles in the specification. Furthermore, the Examiner never suggested that the metal powder in the form of scales or cores with coatings around the cores would be interpreted as "atoms". It is unclear what conveyed this to Applicant.

Applicant appears to be arguing that Mei's solder particles are not scales. However, there is no recitation of "particles" in the claim. And as listed on page 3 of Applicant's arguments, scales are a type of particle.

Applicant finally argues that the claims clearly convey that the metal would not be melted after the reflow and solidification of the solder mass. However, the claims do not exclude another further heating step during which the metal would melt after the heating step in which the solder melts.

Conclusion

4. This is an RCE of applicant's earlier Application No. 10/586,598. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEGHA MEHTA whose telephone number is (571)270-3598. The examiner can normally be reached on Monday to Friday 8:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1783

/Megha Mehta/
Examiner, Art Unit 1783